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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

FRENEL, VANEL

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/663,363	Applicant(s) WONG, YOON KEAN	
	Examiner Vanel Frenel	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Amendment filed on 11/18/05. Claims 1, 9, 16, 18 and 21 have been amended. Claims 1-24 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goyal et al (5,873,108), Koyabu et al (6,026,333) in view of Conmy et al (6,101,480), for substantially the same reasons given in the previous Office Action and incorporated herein. Further reasons will appear hereinbelow.

(A) Claim 1 has been amended to include the words "handheld, by referencing a real-time clock". However, this changes does not affect the scope and the breadth of the claim as originally presented and/or in the manner in which was interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(B) Claim 9 has been amended to include the words “handheld”, “real-time”, “handheld” and “handheld”. However, this changes does not affect the scope and the breadth of the claim as originally presented and/or in the manner in which was interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(C) Claim 16 has been amended to include the words “programmed processor”, “programmed processor”. However, this changes does not affect the scope and the breadth of the claim as originally presented and/or in the manner in which was interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(D) Claim 18 has been amended to include the words “operating” and “handheld”. However, this changes does not affect the scope and the breadth of the claim as originally presented and/or in the manner in which was interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(E) Claim 21 has been amended to include the words “handheld”, “based on a real-time clock”, “handheld” and “handheld”. However, this changes does not affect the

scope and the breadth of the claim as originally presented and/or in the manner in which was interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(F) Claims 2-8, 10-15, 17, 19-20 and 22-24 have not been amended and are therefore rejected for the same reasons given in the previous Office Action, and incorporated herein.

Response to Arguments

4. Applicant's arguments filed on 11/18/05 with respect to claims 1-24 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed on 11/18/05.

(A) At pages 8-11 of the 11/18/05 response, Applicant argues the followings:

(1) Goyal, Koyabu and Conmy references do not suggest, teach the invention as claimed in claimed in independent claims 1, 9, 16 and 21 in which a default data category in a handheld computer is set based upon a clock TOD, day of week, and a TOD profile, wherein data categories can include a block of time corresponding to two or more days.

(2) The Examiner's rejection for obviousness is improper because there is nothing in the cited prior art references either singly or in combination, to suggest the desirability of the claimed subject matter. That the construction in a particular prior art reference would have resulted in the claimed combination had it followed the "common

practice" of attaching certain parts does not show obviousness at the time of the invention but rather reflects improper hindsight analysis and the reading into the art of Applicant's own teachings.

(B) With respect to Applicant's first argument, Examiner respectfully submitted that He had relied upon the clear and unmistakable teaching of the reference of Goyal which stated:" Referring now to FIG. 1, a computing device 100 suitable for use with the present personal information manager is shown. The computing device 100 is shown as being a hand-held, pen-based computer, or PDA, having an LCD touch-screen display 101 and a stylus 105. Although the present invention will, for convenience, be described in terms of such a computing device, it should be understood that the invention is applicable to personal information manager software running on personal computing devices of various descriptions, including desktop computers, laptops, notebooks, sub-notebooks, PDAs, etc. Referring to FIG. 2, in one exemplary embodiment, the computing device 100 of FIG. 1 includes a microprocessor 201 and, connected to the microprocessor 201, control logic 203. Together, the microprocessor 201 and the control logic 203 make up the device "core." The microprocessor 201 and the control logic 203 are connected to a central bus 205 including address, data and control lines. Also connected to the bus 205 are memory devices, including a static RAM 207 and an EPROM 209, a PCMCIA connector 211, a real-time clock 213, an LCD controller 215 and a touch-screen interface 217. The LCD controller 215 is connected in turn to video RAM 219 and the LCD display 220. The touch-screen interface 217 is connected to a

touch-screen 221. Together, the LCD display 220 and the touch-screen 221 form the LDC touch-screen display 101 of FIG. 1. Power to each of the foregoing devices is supplied by a power management unit 223 from a battery 224. In the illustrated embodiment, the power management unit 223 produces three different operating voltages for use by various ones of the devices. As contrasted with prior-art personal information managers based on the traditional paper/pencil paradigm, the present personal information manager is based on what may be referred to as a tag paradigm, which allows different types of information to be entered and from a single screen display in a consistent manner, and likewise allows different types of information to be retrieved from a single screen display in a consistent manner. The tag paradigm, and the ease-of-use it promotes, may best be understood from a description of a user's interaction with the personal information manager. In a preferred embodiment, the personal information manager is used with a touch-screen device. Screen displays are presented to the user, in response to which the user touches the screen to command an action by the device. A "home-screen" of the present personal information manager is shown in FIG. 3 and, with certain exceptions described below, serves as the starting point for all or most user interactions with the personal information manager. A principal feature of the screen display of FIG. 3 is column of lines labelled "TAG." These lines are used to enter a tag for most (if not all) entries, in accordance with the tag paradigm to be presently described. A column labelled "TIME" precedes the TAG column, and a column labelled "TEXT" follows. A fourth column used to enter notes and a fifth "checkbox" column also appear, but are used primarily for convenience and are not essential.

When making an entry in the personal information manager, the user first enters a time, if applicable, for example the time of an appointment or a time to do a particular task, or the time of an event during which an expense was incurred. To do so, the user touches the screen within the TIME column of the line 301. To provide for instances in which new data must be entered (instead of merely selecting a previous entry from a pop-up screen display, for example), a standard keyboard is displayed in an area 303 of the screen display. In large part, however, the manner of entering data within a particular data field uses pop-up screen displays and is context-sensitive. For example, when a time is to be entered, the context changes, causing a time-table pop-up screen display, illustrated in FIG. 4, to be displayed. A block of time is specified by dragging the stylus from a selected starting time to a selected ending time. The selected starting time will then be displayed in the time field (previously empty) selected by the user. To avoid an excess of detail, the selected ending time is not normally displayed, but may be displayed by once again selecting the time field by touching within it, causing the time-table pop-up screen display to again appear, having the time from the starting time to the ending time displayed" which correspond to Applicant's claimed feature. Therefore, Applicant argument is not persuasive and the rejection is hereby sustained.

(C) With respect to Applicant's second argument, Examiner respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner in

the previous Office Actions, incorporated herein, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93). Each applied reference does not expressly suggest combination with the other respective references; however, the Examiner has shown that motivation for combining the references existed in the prior art. Within the present combinations, all of the modifications proposed by the Examiner are taught by the references and that knowledge generally available to one of ordinary skill in the art. Therefore, the combination of references is proper and the rejection is sustained.

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves.

References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

Nonetheless, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner in the previous Office Action, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Furthermore, it is respectfully submitted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed

invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The skilled artisan would not consider the prior art embodiments in a vacuum, but would have had the motivation to combine the advantageous features of the prior art in the manner purported by the Examiner for the reasons and motivations given in the prior Office Action. Thus, the teachings of Goyal, Koyabu and Conmy when considered with the knowledge that is generally available to one of ordinary skill in the art make obvious the limitations that Applicant disputes.

Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention. Note, for example, the motivations explicitly stated of the previous Office Action. Moreover, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specifically support that particular motivation and/or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately

provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

In addition, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Therefore, Applicant's arguments are non-persuasive and the rejection is hereby sustained.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on 6:30am-5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

V.F

V.F

January 24, 2006


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER